

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors:	Travis J. Parry, et al.	Examiner:	Gerald A. Smarth
Serial No.:	10/615,764	Group Art Unit:	2446
Filed:	July 9, 2003	Docket No.:	200207046-1
Title:	Methods and Systems for Providing Email Messages to a Printing Device		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the Final Office Action mailed March 4, 2009 and Notice of Appeal mailed May 4, 2009.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences known to Appellant, Appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Appeal Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-2, 7-16, 25-29, and 41-52 are pending in the application and stand finally rejected. Claims 3 and 53 were canceled, and claims 4-6, 17-24, and 30-40 were withdrawn. The rejection of claims 1-2, 7-16, 25-29, and 41-52 is appealed.

The final office action mailed 03/04/2009 on page 2 under "Disposition of Claims" omits claim 16 as pending in the application.

IV. STATUS OF AMENDMENTS

No amendments were made after receipt of the Final Office Action. All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R.

§ 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element or that these are the sole sources in the specification supporting the claim features.

Claim 1

A method of providing email messages to a printing device, said method comprising (Fig. 5 shows a method of providing email messages for a printing device: lines 1-2 of paragraph [0014] on p. 3):

attaching a memory module storing said email messages to a printing device consumable (Email messages are loaded into a memory module, and then the memory module is affixed to a consumable that is used by a printing device: Fig. 5, #200 and 201: lines 1-6 of paragraph [0047] on p. 12.);

uploading said email messages from the memory module of the printing device consumable to the printing device (The email messages are uploaded from the memory module to a memory of the printing device: Fig. 5, #209a: lines 2-4 of paragraph [0051] on p. 13.); and

transmitting said email messages from the printing device to a recipient to indicate a condition relating to the printing device (The email messages are used to send email alerts to designated recipients based on conditions, such as low toner, of the printing device: Fig. 5, #210a: lines 4-5 of paragraph [0052] on p. 13.).

Claim 7

A method for providing email messages for email alerts from a printing device, said method comprising (Fig. 5 shows a method of providing email messages for a printing device: lines 1-2 of paragraph [0014] on p. 3):

storing email messages on a memory module (Email messages are loaded into a memory module: Fig. 5, #200: lines 2-3 of paragraph [0047] on p. 12.);

attaching said memory module to a printing device consumable (The memory module is affixed to a consumable that is used by a printing device: Fig. 5, #201: lines 4-6 of paragraph [0047] on p. 12.);

installing said printing device consumable with attached memory module in a printing device (The consumable with the memory module is installed in the printing device: Fig. 5, #202: lines 1-2 of paragraph [0048] on p. 12.); and

interfacing said memory module with said printing device (If the email message interface is compatible with the printing device, then an existing email message interface is performed: Fig. 5, #206a: lines 1-3 of paragraph [0049] on p. 12.).

Claim 9

The method of claim 7, further comprising uploading said email messages from said memory module to a memory unit of said printing device (Figure 4, #209: Upload email messages from the consumable to the printing device memory: lines 4-6 of paragraph [0046] on p. 12.).

Claim 41

A consumable for use with a printing device, said consumable comprising (Fig. 2 shows a printing device consumable with an affixed memory module: lines 1-2 of paragraph [0011] on p. 3.):

a printing device consumable (Figure 2, #120 shows a printing device consumable that is placed in a printer: lines 1-2 of paragraph [0023] on p. 5.);

a memory module attached to said printing device consumable (Figure 2, #110 shows a memory module that attaches to the printing device consumable: lines 1-2 of paragraph [0023] on p. 5.); and

email messages stored on said memory module (Figure 2, #102 shows email messages stored in the memory module: lines 1-2 of paragraph [0018] on p. 4.).

Claim 47

A printing device comprising (Figure 3 shows a printing device: lines 1-2 of paragraph [0012] on p. 3.):

a printing device controller (Fig. 3, #133) with an email engine (Fig. 3, #135) for using email messages provided by a memory module (Fig. 3, #110) attached to a printing device consumable (Fig. 3, #120: Upon installation, the email messages (103) and email message interface (104), in conjunction with an operable email engine (135, FIG. 3), enable a computer or other processing device, such as a printer or printing device, to send email messages (103) to specified email addresses through a network to which the processing device is connected: lines 1-4 of paragraph [0021] on pages 4-5.);

a printing device memory (Fig. 3, #132) storing said email engine (The email messages are stored in memory of the printing device: lines 2-4 of paragraph [0028] on p. 6.); and

a printing device interface (Fig. 3, #131) disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device (The printing device interface (131) will correspond to the module interface (105) to allow communication between the memory module (110) and the printing device (130): lines 3-4 of paragraph [0027] on p. 6.);

wherein said printing device controller is configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine (When the email messages (103, FIG. 1) are uploaded and stored in the memory unit (132), the controller (133) can then use the email messages (103, FIG. 1), for example, to alert designated recipients of conditions in the printing device (130): lines 1-3 of paragraph [0031] on p. 7.).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 2 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2002/0075500 (Kurz).

Claims 7-16, 25-28, 41, 45-47, and 51-53 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita).

Claim 14 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2002/0075500 (Kurz).

Claim 29 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and USPN 6,831,755 (Narushima).

Claims 41, 45, and 46 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,735,399 (Tabb) in view of US publication number 2003/0107762 (Kinoshita).

Claim 42 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,735,399 (Tabb) in view of US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa).

Claims 43 and 44 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,735,399 (Tabb) in view of US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa) and USPN 6,532,351 (Richards).

Claim 48 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa).

Claims 49 and 50 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa) and USPN 6,532,351 (Richards).

VII. ARGUMENT

The rejection of claims 1-2, 7-16, 25-29, and 41-52 is improper, and Appellants respectfully request reversal of these rejections.

The claims do not stand or fall together. Instead, Appellants present separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

Principles of Law: Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification (see *In re Prater*, 415 F.2d 1393,1404-05 (CCPA 1969); *In re Am. A cad. a/Sci.Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

Although a patent applicant is entitled to be his or her own lexicographer of terms in a claim, in *ex parte* prosecution the lexicography must be within limits. *In re Carr*, 347 F.2d 578,580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Principles of Law: Obviousness

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385.

According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G)

Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claim Rejections: 35 USC § 103(a)

Claims 1 and 2 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2002/0075500 (Kurz). These rejections are traversed.

Claims 1 and 2 recite one or more elements that are not taught or suggested in Muto in view of Tabb, Kinoshita, and Kurz. These missing elements show that the differences between the combined teachings in the art and the recitations in the claims are great. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

Sub-Heading: Claims 1 and 2

Independent claim 1 is selected for discussion.

As one example, independent claim 1 recites attaching a memory module storing email messages to a printing device consumable. Muto in view of Tabb, Kinoshita, and Kurz does not teach or suggest this claim element.

The examiner admits that “Muto does not specifically teach method comprising a memory module storing said email messages to a printing device consumable” (see Final OA mailed 03/04/2009 at p. 3). The examiner also admits the following: “Neither Muto nor Tabb specifically teaches emails being stored on a memory module” (see Final OA mailed 03/04/2009 at p. 5). Appellants agree with these admissions. The examiner, however, attempts to cure these deficiencies with the combination of Kinoshita and Kurz. Appellants respectfully traverse.

Muto teaches a printer that includes a mail message generation unit that generates transmission data to a client apparatus or personal computer (see Muto at lines 4-9 of paragraph [0041]). The printer monitors its status and generates device status information. A status message transmission unit in the printer can transmit the information about the status of the device to a client apparatus (see Muto at paragraphs [0044] and [0045]).

Tabb teaches a Customer Replaceable Unit (CRU) or print cartridge having a memory that stores software code upgrades. The print cartridge provides software updates to the CPU of the printer. Nowhere does Tabb teach or even suggest that the print cartridge or CRU stores email messages. Instead, Tabb teaches that the print cartridge or CRU stores software code updates.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user’s computer, through an email server, and to the printer). The printer then prints the file attached to the received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita stores email messages.**

Kurz teaches a method for informing a user when a customer replaceable unit, CRU, (such as a print cartridge) of a printer or photocopier should be replaced. The CRU includes a memory (CRUM) that stores a number of images (i.e., a number of copies) that

the CRU can make before running out of ink or toner (see Kurz at paragraph [0022]). When the number of images remaining on the CRU reaches a preprogrammed level, a user is notified with a printed document at the printing machine (see lines 4-5 of paragraph [0022]). Paragraph [0020] in Kurz expressly teaches what information is stored in the CRUM. Nowhere does Kurz teach or even suggest that the CRUM stores “email messages.” Instead, Kurz focuses on the fact that the CRUM stores “a preset number of total images for the CRU” (see paragraph [0020]).

The difference between Kurz and the recitations of claim 1 are quite significant. Claim 1 recites that the memory of the printing device consumable stores **email messages**. Kurz mentions that an email can be sent to a user indicating that the CRU is low on ink (see paragraph [0031]). Importantly, however, the emails being sent to the user in Kurz are not stored in the CRUM of the CRU.

The combination of Muto in view of Tabb, Kinoshita, and Kurz teaches a print cartridge attachable to a printer. The print cartridge has a memory that stores software code upgrades which are provided to the CPU of the printer. The memory also stores a number of images or copies that can be made. The printer, in turn, can transmit information about the status of the printer to a client apparatus. The printer can also receive emails with attached files that are printed at the printer. The printer can also print a document when the number of images remaining in the CRU is low. **The combination of Muto, Tabb, Kinoshita and Kurz fails to teach or even suggest that the print cartridge stores email messages.** Muto and Tabb teach that emails can be transmitted from the printer to a client, but these email messages are never stored in the print cartridge. The addition of Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge. The printer can also store email information, such as email addresses, but this information is not stored in the print cartridge of the printer. Kurz teaches that an email can be sent to a user to notify the user when the print cartridge is low. This email, however, is not stored in a memory of the print cartridge.

The differences between the claims and the teachings in the art are great since the references fail to teach or suggest all of the claim elements. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

For at least these reasons, claims 1 and 2 are allowable over the art of record.

As another example, claim 1 recites that the email messages are uploaded from the memory module of a printing device consumable to a printing device. By way of example, emails are uploaded from a print cartridge to the printer. Muto in view of Tabb, Kinoshita, and Kurz does not teach or suggest this claim element.

Muto teaches a printer that includes a mail message generation unit that generates transmission data to a client apparatus or personal computer (see Muto at lines 4-9 of paragraph [0041]). The printer monitors its status and generates device status information. A status message transmission unit in the printer can transmit the information about the status of the device to a client apparatus (see Muto at paragraphs [0044] and [0045]).

Tabb teaches a print cartridge having a memory that stores software code upgrades which are provided to a printer. Nowhere does Tabb teach or even suggest that the print cartridge or CRU uploads email messages to the printer. Instead, Tabb teaches that the print cartridge or CRU stores software code updates.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user's computer, through an email server, and to the printer). The printer then prints the file attached to the received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita uploads email messages.**

Kurz teaches a method for informing a user when a customer replaceable unit, CRU, (such as a print cartridge) of a printer or photocopier should be replaced. The CRU includes a memory (CRUM) that stores a number of images (i.e., a number of copies) that the CRU can make before running out of ink or toner (see Kurz at paragraph [0022]). When the number of images remaining on the CRU reaches a preprogrammed level, a user is notified with a printed document at the printing machine (see lines 4-5 of

paragraph [0022]). Paragraph [0020] in Kurz expressly teaches what information is stored in the CRUM. Nowhere does Kurz teach or even suggest that the CRUM stores “email messages.” Instead, Kurz focuses on the fact that the CRUM stores “a preset number of total images for the CRU” (see paragraph [0020]).

The difference between Kurz and the recitations of claim 1 are quite significant. Claim 1 recites that the **email messages are uploaded from the memory module of a printing device consumable to a printing device**. Kurz mentions that an email can be sent to a user indicating that the CRU is low on ink (see paragraph [0031]). Importantly, however, the emails being sent to the user in Kurz are not stored in the CRUM of the CRU.

The combination of Muto, Tabb, Kinoshita, and Kurz teaches a print cartridge attachable to a printer. The print cartridge has a memory that stores software code upgrades which are provided to the CPU of the printer. The memory also stores a number of images or copies that can be made. The printer, in turn, can transmit information about the status of the printer to a client apparatus. The printer can also receive emails with attached files that are printed at the printer. **The combination of Muto and Tabb fails to teach or even suggest that the print cartridge uploads email messages to the printer.** Muto and Tabb teach that emails can be transmitted from the printer to a client, but these email messages are never uploaded from the print cartridge to the printer. The addition of Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge or uploaded from a print cartridge to the printer. Kurz teaches that email messages are sent to a user when the print cartridge is low, but the print cartridge itself does not store these emails. The print cartridge in Kurz, thus, does not upload emails to the printer.

The differences between the claims and the teachings in the art are great since the references fail to teach or suggest all of the claim elements. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

For at least these reasons, claims 1 and 2 are allowable over the art of record.

Claim Rejections: 35 USC § 103(a)

Claims 7-16, 25-28, 41, 45-47, and 51-53 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita). These rejections are traversed.

Claims 7-16, 25-28, 41, 45-47, and 51-53 recite one or more elements that are not taught or suggested in Muto in view of Tabb and Kinoshita. These missing elements show that the differences between the combined teachings in the art and the recitations in the claims are great. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

Sub-Heading: Claims 7-16 and 25-28

Independent claim 7 is selected for discussion.

As one example, independent claim 7 recites storing email messages on a memory module and then attaching the memory module to a printing device consumable. Muto in view of Tabb and Kinoshita does not teach or suggest these claim elements.

The examiner admits that “Muto does not explicitly teach storing attaching said memory modules to a printing device consumable; installing said printing device consumable with attached memory module in a printing device; and interfacing said memory module with said printing device” (see Final OA mailed 03/04/2009 at p. 11). The examiner also admits the following: “Neither Muto nor Tabb specifically teaches emails being stored on a memory module” (see Final OA mailed 03/04/2009 at p. 12). Appellants agree with these admissions. The examiner, however, attempts to cure these deficiencies with the combination of Kinoshita. Appellants respectfully traverse.

Muto teaches a printer that includes a mail message generation unit that generates transmission data to a client apparatus or personal computer (see Muto at lines 4-9 of paragraph [0041]). The printer monitors its status and generates device status information. A status message transmission unit in the printer can transmit the information about the status of the device to a client apparatus (see Muto at paragraphs [0044] and [0045]).

Tabb teaches a Customer Replaceable Unit (CRU) or print cartridge having a memory that stores software code upgrades. The print cartridge provides software updates to the CPU of the printer. Nowhere does Tabb teach or even suggest that the print cartridge or CRU stores email messages. Instead, Tabb teaches that the print cartridge or CRU stores software code updates.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user's computer, through an email server, and to the printer). The printer then prints the file attached to the received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita stores email messages.**

The combination of Muto in view of Tabb and Kinoshita teaches a print cartridge attachable to a printer. The print cartridge has a memory that stores software code upgrades which are provided to the CPU of the printer. The printer, in turn, can transmit information about the status of the printer to a client apparatus. The printer can also receive emails with attached files that are printed at the printer. **The combination of Muto, Tabb, and Kinoshita fails to teach or even suggest that the print cartridge stores email messages.** Muto and Tabb teach that emails can be transmitted from the printer to a client, but these email messages are never stored in the print cartridge. The addition of Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge. The printer can also store email information, such as email addresses, but this information is not stored in the print cartridge of the printer.

The differences between the claims and the teachings in the art are great since the references fail to teach or suggest all of the claim elements. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

For at least these reasons, claims 7-16 and 25-28 are allowable over the art of record.

Sub-Heading: Dependent Claim 9

Dependent claim 9 recites uploading said email messages from said memory module to a memory unit of said printing device. The examiner argues that this claim element is taught in Kinoshita. Appellants respectfully disagree.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user's computer, through an email server, and to the printer). The printer then prints the file attached to the received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita stores email messages. Therefore, the printing device consumable in Kinoshita cannot upload email messages to a printing device.**

The combination of Muto in view of Tabb and Kinoshita teaches a print cartridge attachable to a printer. The print cartridge has a memory that stores software code upgrades which are provided to the CPU of the printer. The printer, in turn, can transmit information about the status of the printer to a client apparatus. The printer can also receive emails with attached files that are printed at the printer. **The combination of Muto, Tabb, and Kinoshita fails to teach or even suggest that the print cartridge stores email messages and uploads the emails to a printing device.** Muto and Tabb teach that emails can be transmitted from the printer to a client, but these email messages are never stored in the print cartridge or uploaded to a printing device. The addition of Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge. The printer can also store

email information, such as email addresses, but this information is not stored in the print cartridge of the printer or uploaded from the print cartridge to a printing device.

For at least these reasons, dependent claim 9 is allowable over the art of record.

Sub-Heading: Claims 41 and 45-46

Independent claim 41 is selected for discussion.

As one example, independent claim 41 recites a printing device consumable that has a memory module. This memory module stores email messages. Muto in view of Tabb and Kinoshita does not teach or suggest these claim elements.

Appellants note that the examiner has not provided any argument under this section regarding independent claim 41. The examiner has failed to establish a prima facie case in rejecting independent claim 41 in this section. Nonetheless, Appellants present arguments to show that Muto in view of Tabb and Kinoshita does not teach or suggest the elements of claim 41.

The examiner admits that “Muto does not explicitly teach storing attaching said memory modules to a printing device consumable; installing said printing device consumable with attached memory module in a printing device; and interfacing said memory module with said printing device” (see Final OA mailed 03/04/2009 at p. 11). The examiner also admits the following: “Neither Muto nor Tabb specifically teaches emails being stored on a memory module” (see Final OA mailed 03/04/2009 at p. 12). Appellants agree with these admissions. The examiner, however, attempts to cure these deficiencies with the combination of Kinoshita. Appellants respectfully traverse.

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Tabb teaches a Customer Replaceable Unit (CRU) or print cartridge having a memory that stores software code upgrades. The print cartridge provides software updates to the CPU of the printer. Nowhere does Tabb teach or even suggest that the print

cartridge or CRU stores email messages. Instead, Tabb teaches that the print cartridge or CRU stores software code updates.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user's computer, through an email server, and to the printer). The printer then prints the file attached to the received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita stores email messages.**

The combination of Muto in view of Tabb and Kinoshita teaches a print cartridge attachable to a printer. The print cartridge has a memory that stores software code upgrades which are provided to the CPU of the printer. The printer, in turn, can transmit information about the status of the printer to a client apparatus. The printer can also receive emails with attached files that are printed at the printer. **The combination of Muto, Tabb, and Kinoshita fails to teach or even suggest that the print cartridge stores email messages.** Muto and Tabb teach that emails can be transmitted from the printer to a client, but these email messages are never stored in the print cartridge. The addition of Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge. The printer can also store email information, such as email addresses, but this information is not stored in the print cartridge of the printer.

The differences between the claims and the teachings in the art are great since the references fail to teach or suggest all of the claim elements. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

For at least these reasons, claims 41 and 45-46 are allowable over the art of record.

Sub-Heading: Claims 47 and 51-53

Independent claim 47 is selected for discussion.

As one example, independent claim 47 recites “wherein said printing device controller is configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine.” Muto in view of Tabb and Kinoshita does not teach or suggest these claim elements.

The examiner admits that “Muto does not explicitly teach a memory module attached to a printing device consumable; a printing device memory storing said email engine; and a printing device interface disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device” (see Final OA mailed 03/04/2009 at p. 20). The examiner also admits the following: “Neither Muto nor Tabb specifically teaches emails being stored on a memory module” (see Final OA mailed 03/04/2009 at p. 22). Appellants agree with these admissions. The examiner, however, attempts to cure these deficiencies with the combination of Kinoshita. Appellants respectfully traverse.

Muto teaches a printer that includes a mail message generation unit that generates transmission data to a client apparatus or personal computer (see Muto at lines 4-9 of paragraph [0041]). The printer monitors its status and generates device status information. A status message transmission unit in the printer can transmit the information about the status of the device to a client apparatus (see Muto at paragraphs [0044] and [0045]).

Tabb teaches a Customer Replaceable Unit (CRU) or print cartridge having a memory that stores software code upgrades. The print cartridge provides software updates to the CPU of the printer. Nowhere does Tabb teach or even suggest that the print cartridge or CRU stores email messages. Instead, Tabb teaches that the print cartridge or CRU stores software code updates.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user’s computer, through an email server, and to the printer). The printer then prints the file attached to the

received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita stores email messages.**

The combination of Muto in view of Tabb and Kinoshita teaches a print cartridge attachable to a printer. The print cartridge has a memory that stores software code upgrades which are provided to the CPU of the printer. The printer, in turn, can transmit information about the status of the printer to a client apparatus. The printer can also receive emails with attached files that are printed at the printer. **The combination of Muto, Tabb, and Kinoshita fails to teach or even suggest that printer access email messages stored in the print cartridge or that the printer loads emails from the print cartridge to the printer.** Muto and Tabb teach that emails can be transmitted from the printer to a client, but these email messages are never stored in the print cartridge. The addition of Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge. The printer can also store email information, such as email addresses, but this information is not stored in the print cartridge of the printer.

The differences between the claims and the teachings in the art are great since the references fail to teach or suggest all of the claim elements. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

For at least these reasons, claims 47 and 51-53 are allowable over the art of record.

Claim Rejections: 35 USC § 103(a)

Claim 14 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2002/0075500 (Kurz). This rejection is traversed.

As explained above, Muto in view of Tabb and Kinoshita fail to teach or suggest all of the elements of independent claim 7. Kurz fails to cure these deficiencies. For at least these reasons, dependent claim 14 is allowable.

Claim Rejections: 35 USC § 103(a)

Claim 29 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and USPN 6,831,755 (Narushima). This rejection is traversed.

As explained above, Muto in view of Tabb and Kinoshita fail to teach or suggest all of the elements of independent claim 7. Narushima fails to cure these deficiencies. For at least these reasons, dependent claim 29 is allowable.

Claim Rejections: 35 USC § 103(a)

Claims 41, 45, and 46 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,735,399 (Tabb) in view of US publication number 2003/0107762 (Kinoshita). These rejections are traversed.

Claims 41, 45, and 46 recite one or more elements that are not taught or suggested in Tabb in view Kinoshita. These missing elements show that the differences between the combined teachings in the art and the recitations in the claims are great. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

Sub-Heading: Claims 41, 45, and 46

Independent claim 41 is selected for discussion.

Independent claim 41 recites a memory module attached to a printing device consumable, and email messages stored on the memory module. Tabb in view Kinoshita does not teach or suggest this claim element.

The examiner admits that “Tabb does not specifically teach emails being stored on a memory module” (see Final OA mailed 03/04/2009 at p. 28). Appellants agree with these admissions. The examiner, however, attempts to cure these deficiencies with the combination of Kinoshita. Appellants respectfully traverse.

Tabb teaches a Customer Replaceable Unit (CRU) or print cartridge having a memory that stores software code upgrades. The print cartridge provides software updates to the CPU of the printer. Nowhere does Tabb teach or even suggest that the print cartridge or CRU stores email messages. Instead, Tabb teaches that the print cartridge or CRU stores software code updates.

Kinoshita teaches a server that stores information about plural printers and provides this information to a user of a computer. The user then sends an e-mail with an attached file to one of the printers (the e-mail transmits from the user's computer, through an email server, and to the printer). The printer then prints the file attached to the received e-mail. Kinoshita further teaches that the printer includes a memory card for storing the received e-mail and attached file. This memory card can also store data representing connection information for connecting the printer to the mail server, a user ID, a password, an e-mail address (see Kinoshita at paragraph [0229]). The memory card of Kinoshita is not attached to a printing device consumable, such as a print cartridge. **No printing device consumable in Kinoshita stores email messages.**

The combination of Tabb and Kinoshita teaches a print cartridge having a memory that stores software code upgrades which are provided to the CPU of the printer. The printer can receive emails with attached files that are printed at the printer. **The combination of Tabb and Kinoshita fails to teach or even suggest that the print cartridge stores email messages.** Kinoshita teaches that the printer can receive emails with attached files that are printed. These received emails are never stored in the print cartridge. The printer can also store email information, such as email addresses, but this information is not stored in the print cartridge of the printer.

The differences between the claims and the teachings in the art are great since the references fail to teach or suggest all of the claim elements. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

For at least these reasons, claims 41, 45, and 46 are allowable over the art of record.

Claim Rejections: 35 USC § 103(a)

Claim 42 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,735,399 (Tabb) in view of US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa). This rejection is traversed.

As explained above, Tabb in view of Kinoshita fail to teach or suggest all of the elements of independent claim 41. Hatasa fails to cure these deficiencies. For at least these reasons, dependent claim 42 is allowable.

Claim Rejections: 35 USC § 103(a)

Claims 43 and 44 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,735,399 (Tabb) in view of US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa) and USPN 6,532,351 (Richards). These rejections are traversed.

As explained above, Tabb in view of Kinoshita fail to teach or suggest all of the elements of independent claim 41. Hatasa and Richards fail to cure these deficiencies. For at least these reasons, dependent claims 43 and 44 are allowable.

Claim Rejections: 35 USC § 103(a)

Claim 48 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa). This rejection is traversed.

As explained above, Muto in view of Tabb and Kinoshita fail to teach or suggest all of the elements of independent claim 47. Hatasa fails to cure these deficiencies. For at least these reasons, dependent claim 48 is allowable.

Claim Rejections: 35 USC § 103(a)

Claims 49 and 50 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2002/0116480 (Muto) in view of USPN 6,735,399 (Tabb) and US publication number 2003/0107762 (Kinoshita) and US publication number 2003/0214546 (Hatasa) and USPN 6,532,351 (Richards). This rejection is traversed.

As explained above, Muto in view of Tabb and Kinoshita fail to teach or suggest all of the elements of independent claim 47. Hatasa and Richards fail to cure these deficiencies. For at least these reasons, dependent claims 49 and 50 are allowable.

CONCLUSION

In view of the above, Appellants respectfully request the Board of Appeals to reverse the Examiner's rejection of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
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Respectfully submitted,

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VIII. Claims Appendix

1. (previously presented) A method of providing email messages to a printing device, said method comprising:

attaching a memory module storing said email messages to a printing device consumable;

uploading said email messages from the memory module of the printing device consumable to the printing device; and

transmitting said email messages from the printing device to a recipient to indicate a condition relating to the printing device.

2. (original) The method of claim 1, further comprising:

installing said printing device consumable in said printing device; and

interfacing said printing device and said memory module.

3. (canceled)

4. (withdrawn) The method of claim 2, further comprising uploading an email message interface from said memory module to a memory of said printing device.

5. (withdrawn) The method of claim 3, further comprising executing said email message interface with a controller of said printing device.

6. (withdrawn) The method of claim 5, further comprising using said email messages on

said memory module through said email message interface.

7. (original) A method for providing email messages for email alerts from a printing device, said method comprising:

storing email messages on a memory module;

attaching said memory module to a printing device consumable;

installing said printing device consumable with attached memory module in a printing device; and

interfacing said memory module with said printing device.

8. (original) The method of claim 7, wherein said printing device consumable comprises a toner cartridge.

9. (original) The method of claim 7, further comprising uploading said email messages from said memory module to a memory unit of said printing device.

10. (original) The method of claim 9, further comprising sending an email alert to one or more recipients using one of said email messages indicative of a condition of said printing device.

11. (original) The method of claim 10, wherein said email messages comprise fields for containing printing device information.

12. (original) The method of claim 11, wherein said printing device information comprises an identification of said printing device.

13. (original) The method of claim 11, wherein said printing device information comprises a quantification of a remaining amount of a consumable.

14. (original) The method of claim 11, wherein said email message comprises an order for additional consumables sent to a provider of said consumables.

15. (original) The method of claim 10, wherein said sending an email alert comprises:
monitoring operation of said printing device for occurrence of a trigger event;
inserting said printing device information into said email messages; and
sending said email alert using said email messages in response to said trigger event, wherein said email messages are specific to the trigger event detected.

16. (original) The method of claim 15, further comprising receiving user input to specify a list of trigger events.

17. (withdrawn) The method of claim 7, further comprising: uploading an email message interface from said memory module to said printing device; and accessing said email messages on said memory module with said email message interface.

18. (withdrawn) The method of claim 17, wherein said email messages comprise fields

for containing printing device information.

19. (withdrawn) The method of claim 18, wherein said printing device information comprises an identification of said printing device.

20. (withdrawn) The method of claim 18, wherein said printing device information comprises a quantification of a remaining amount of a consumable.

21. (withdrawn) The method of claim 18, wherein said email message comprises an order for additional consumables sent to a provider of said consumables.

22. (withdrawn) The method of claim 17, further comprising sending an email alert to one or more recipients using one of said email messages indicative of a condition of said printing device.

23. (withdrawn) The method of claim 22, wherein said sending an email alert comprises:
monitoring operation of said printing device for occurrence of a trigger event
inserting said printing device information into said email messages; and
sending said email alert using said email messages in response to said trigger event, wherein said email messages are specific to the trigger event detected.

24. (withdrawn) The method of claim 23, further comprising receiving user input to specify a list of trigger events.

25. (previously presented) The method of claim 9, wherein said uploading said email message elements to printing device memory comprises:

determining if previous email message elements already exist in said printing device memory; and

uploading said email message elements to printing device memory if no previous email message elements are found.

26. (original) The method of claim 9, wherein said uploading said email message elements to printing device memory comprises:

determining if previous email messages already exist in said memory unit of said printing device; and

performing a replacement action if previous email message elements are found.

27. (original) The method of claim 26, wherein said performing a replacement action comprises replacing one or more of said previous email messages with one or more email messages from said memory module.

28. (original) The method of claim 26, wherein said performing a replacement action comprises adding one or more of said email messages from said memory module to said previous email messages.

29. (original) The method of claim 26, wherein said performing a replacement action

requires an administration setting, password, or other form of authentication.

30. (withdrawn) A method for providing email messages for email alerts from a printing device, said method comprising:

- storing email messages and an email message interface on a memory module;
- attaching said memory module to a printing device consumable;
- installing said printing device consumable with attached memory module in a printing device; and
- uploading said email message interface to a printing device memory.

31. (withdrawn) The method of claim 30, wherein said printing device consumable comprises a toner cartridge.

32. (withdrawn) The method of claim 30, further comprising accessing said email messages on said memory module using said email message interface.

33. (withdrawn) The method of claim 32, further comprising sending an email alert to one or more recipients using said email messages indicative of a condition of said printing device.

34. (withdrawn) The method of claim 33, wherein said sending an email alert comprises:
monitoring operation of said printing device for occurrence of a trigger event
inserting said printing device information into said email messages; and

sending said email alert using said one or more of said email messages in response to said trigger event, wherein said one or more of said email messages are specific to the trigger event detected.

35. (withdrawn) The method of claim 34, further comprising receiving user input to specify a list of trigger events.

36. (withdrawn) A method of providing a customized list of email messages for use by a printing device, said method comprising:

receiving email messages from a purchaser of a printing device consumable;

storing said email messages on a memory module attached to said printing device consumable.

37. (withdrawn) The method of claim 36, further comprising providing said printing device consumable with said memory module to said purchaser.

38. (withdrawn) The method of claim 36, wherein said receiving said email messages from a purchaser comprises receiving said email messages through a terminal at a consumables sales facility.

39. (withdrawn) The method of claim 36, wherein said receiving said email messages from a purchaser comprises receiving said email messages from said purchaser through a computer network.

40. (withdrawn) The method of claim 39, wherein said computer network comprises the Internet.

41. (original) A consumable for use with a printing device, said consumable comprising:

a printing device consumable;

a memory module attached to said printing device consumable; and

email messages stored on said memory module.

42. (original) The consumable of claim 41, further comprising a wireless interface for said memory module for interfacing and communicating with a printing device.

43. (original) The consumable of claim 42, wherein said wireless interface comprises a radio frequency interface.

44. (original) The consumable of claim 42, wherein said wireless interface comprises an infrared interface.

45. (original) The consumable of claim 41, further comprising a wired interface for said memory module for interfacing and communicating with a printing device.

46. (original) The consumable of claim 41, further comprising an email message interface stored on said memory module which, when uploaded to a printing device, allows access

and use of said email messages on said memory module.

47. (previously presented) A printing device comprising:

a printing device controller with an email engine for using email messages provided by a memory module attached to a printing device consumable;

a printing device memory storing said email engine; and

a printing device interface disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device;

wherein said printing device controller is configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine.

48. (original) The printing device of claim 47, wherein said printing device interface comprises a wireless interface.

49. (original) The printing device of claim 48, wherein said wireless interface comprises a radio frequency interface.

50. (original) The printing device of claim 48, wherein said wireless interface comprises an infrared interface.

51. (original) The printing device of claim 47, wherein said printing device interface comprises a wired interface.

52. (original) The printing device of claim 47, further comprising a user interface for controlling said printing device.

53. (canceled)

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.